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EXAMINER	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ELIJAHU SHAPIRA and
VICTOR LU

Appeal 2008-1760
Application 09/707,541
Technology Center 3600

Decided: January 22, 2009

Before HUBERT C. LORIN, ANTON W. FETTING, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Elijahu Shapira, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-9. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE. [1]

THE INVENTION

The invention relates "to compiling and reporting data associated with activity on a network server and more particularly to compiling and reporting server data that is associated with commercial activity on a server." Specification 1:5-7. The Specification states that "[p]rograms for analyzing traffic on a network server, such as a worldwide web server, are known in the art." Specification 1:10-11. However, according to the Specification, the "need still remains for a way to track and report commercial activity on the web site – a feature missing in prior art web commerce analysis tools." Specification 2:1-2. The invention is "for tracking and reporting electronic commerce activity over a web site that is stored on a first server coupled to a wide area network." Specification 2:5-6. According to the invention:

> The web page is programmed to include data fields reflecting commerce transaction activity and data mining code. The web page is uploaded to a visitor computer responsive to a request over the wide area network from the visitor computer. Commerce information is accepted within the data fields of the webpage at the visitor computer to form a completed web page. The data mining code is operated on the visitor computer to obtain technical and commercial data and sent to a second

[1] Our decision will make reference to Appellants' Appeal Brief ("App. Br.," filed Feb. 15, 2007) and Reply Brief ("Reply Br.," filed Sep. 26, 2007), and the Examiner's Answer ("Answer," mailed Jul. 26, 2007).

> server on the wide area network for logging and analysis.

Specification 2:6-12.

Claim 1, the sole independent claim, reproduced below, is illustrative of the subject matter on appeal.

> 1. A method for tracking and reporting electronic commerce activity over a web site comprising:
>
> storing a web page on a first server coupled to a wide area network, said web page including data fields reflecting commerce transaction activity and data mining code;
>
> uploading the web page including the data fields and data mining code to a visitor computer responsive to a request over the wide area network from the visitor computer;
>
> accepting commerce information within the data fields of the web page at the visitor computer to form a completed web page;
>
> operating the data mining code on the visitor computer to obtain technical and commercial data; and
>
> receiving the technical and commercial data at a second server.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Papierniak	US 6,128,624	Oct. 3, 2000

"WebSideStory Introduces StatMarket eData Mining -- the Most Powerful Tool Available for Gathering E-commerce knowledge," *Business Wire* (New York, Sep. 21, 1999) (Hereinafter referred to as Business Wire).

The following rejection is before us for review:

1. Claims 1-9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Papierniak and Business Wire.

ISSUES

The issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 1-9 under 35 U.S.C. § 103(a) as being unpatentable over Papierniak and Business Wire. In particular, the issue is whether the Examiner correctly found that the prior art discloses a "web page including data fields reflecting commerce transaction activity and data mining code" (claim 1).

PRINCIPLES OF LAW

Obviousness

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 ("While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.") The Court

in Graham further noted that evidence of secondary considerations "might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." 383 U.S. at 17-18.

ANALYSIS

The Appellants argued that the prior art does not disclose a "web page including data fields reflecting commerce transaction activity and data mining code" (claim 1). App. Br. 5-10. This implicates the scope and content of the cited prior art.

In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of presenting a prima facie case of obviousness. *See In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. *See In re Lintner,* 458 F.2d 1013, 1016 (CCPA 1972).

To establish a prima facie case of obviousness for the subject matter of claim 1, the sole independent claim, the Examiner bore the burden of showing that, given the references cited in rejecting the claim under § 103 for obviousness, one of ordinary skill in the art would have been led to the method claimed. In that regard, the claimed method includes the step of "storing a web page on a first server coupled to a wide area network, said web page including data fields reflecting commerce transaction activity and data mining code" and therefore the Examiner was required to show that, given Papierniak and Business Wire, one of ordinary skill in the art would

have been led to a tracking and reporting method such that a "web page including data fields reflecting commerce transaction activity and data mining code" is stored on a server coupled to a wide area network. Claim 1.

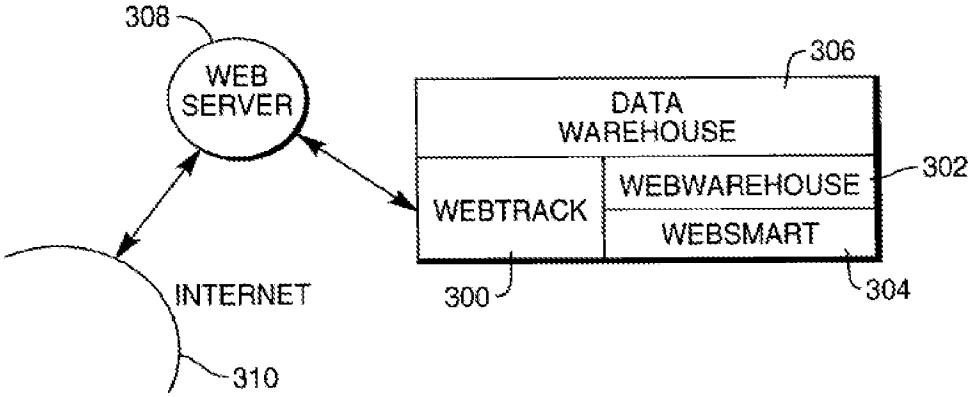
The Examiner stated that

> Papierniak et al. discloses:
>
> > A method for tracking and reporting electronic commerce activity over a web site comprising:
> >
> > storing a web page on a first server (308) coupled to a wide area network, *said web page including data fields reflecting commerce transaction activity and data mining code*; accepting commerce information within the data fields of the web page at the visitor computer to form a completed web page (306; col. 3, lines 13-53).

Answer 3. (Emphasis added.)

Fig. 7 of Papierniak (which shows elements 306 and 308 that the Examiner referred to) is reproduced below:

FIG. 7



Papierniak's Fig. 7 is said to depict "a functional view of the system's elements in an Internet environment." Papierniak, col. 6, ll. 62-63.

Col. 3, lines 13-53, of Papierniak reads as follows:

> In the attainment of the same, the present invention provides an architecture and method of supporting, collecting, storing, and analyzing Internet and/or electronic commerce data over or from the World Wide Web for ISPs and CSPs. The present invention also includes one or more computer systems employing the method, a computer readable memory storing the medium, and a method for storing the synchronization process in memory and in a storage device.
>
> The present invention combines improved methods of data collection, translation and storage with enhanced analysis techniques to exploit the vast amount of information available through emerging uses of the web, and other internet-based systems. The results can be used as part of a customer's decision support system to allow better (e.g., more statistically valid) business decisions to be made faster.
>
> The present invention concentrates on opportunities within, for example, the ISP sector of the telecommunications industry, and provides ISPs the insight into their customer's services usage, demographics, and behavior patterns. Through this insight, ISPs should be able to support their decisions in such areas as customer retention, service pricing and profitability, and target marketing campaign using analytical methods based on customer and market data. Furthermore, ISPs can provide the knowledge and capabilities to the hosted business customers in order for those customers to gain similar insight

> into their users to make effective and customer-driven business decisions.
>
> In addition, the present invention is complementary with the current Internet Services Delivery Platform program. One environment where the present invention operates is where the consumer or business customer is able to utilize the CSP's/ISP's web-based resources through a combination of access and backbone networks which, in turn, are connected to, for example, the global Internet to interface with the rest of the internet resources. The access networks consist of many Point of Presences (POPs) which provide dial-up (e.g., analog/digital, ISDN) access service or dedicated digital (e.g., Frame Relay, ISDN) access service using either modem pool technologies and/or access server/router for the customers.

We do not see in these disclosures any mention of a "web page including data fields reflecting commerce transaction activity and data mining code" as indicated by the Examiner. Answer 3.

Accordingly, the Examiner's statement that Papierniak discloses such a web page amounts to a mere conclusory statement. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR*, 127 S. Ct. at 1741 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). In that regard, the Examiner has not further articulated a reason with some rational underpinning why, notwithstanding that Papierniak does not explicitly disclose a "web page including data fields reflecting commerce transaction

activity and data mining code," one of ordinary skill in the art would nevertheless have been led to a tracking and reporting method whereby a "web page including data fields reflecting commerce transaction activity and data mining code" is stored on a server coupled to a wide area network given what Papierniak and Business Wire disclose. As a result, we find that a prima facie case of obviousness for the claimed subject matter over the cited references has not been made out and we therefore reverse the rejection.

CONCLUSIONS OF LAW

We conclude that the Appellants have shown that the Examiner erred in rejecting claims 1-9 under 35 U.S.C. § 103(a) as being unpatentable over Papierniak and Business Wire.

DECISION

The decision of the Examiner to reject claims 1-9 is reversed.

REVERSED

hh

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